

Appl. No.: 09/782,366
Grp. A.U.: 1714

Remarks

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 1-31 are pending in this application.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 1-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Everhart et al. (US 5,439,734). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that it is very well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990).

Applicant respectfully submits that the Everhart reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element of said claimed invention. More particularly, nowhere within the Everhart reference is the use of a di-C₁₀₋₁₂ fatty acid ester of polyethylene glycol specifically disclosed. This fact, coupled with Applicant's showing of unexpected results associated with the use of a hydrophilicity additive having the claimed narrow C₁₀₋₁₂ fatty acid range versus those additives exemplified in Everhart, i.e., di-oleate esters of polyethylene glycol, results in Everhart failing to anticipate the claimed invention.

While Applicant realizes that the Everhart reference teaches the use of a di-fatty acid ester of polyethylene glycol having a range of carbon atoms which encompasses the claimed di-C₁₀₋₁₂ fatty acid ester of polyethylene glycol, it is Applicant's position that the Everhart reference fails to disclose Applicant's compound with "sufficient specificity to constitute anticipation under the statute" due to Applicant's showing of unexpected results

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associated with the narrower claimed range. See MPEP 2131.03. As a result, it is Applicant's position that the Everhart reference fails to anticipate the claimed invention. Accordingly, for the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1-31 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Everhart et al. (US 5,439,734). This rejection is respectfully traversed for the following reasons.

Applicant respectfully submits that based on the unexpected results associated with Applicant's claimed di-C₁₀₋₁₂ fatty acid esters of polyethylene glycol, as is evidenced by the examples, the claimed subject matter is rendered unobvious over the Everhart reference. Clearly, Everhart fails to appreciate the superior properties associated with the claimed hydrophilicity additive. Consequently, it should not be relied upon to establish prima facie obviousness against the claimed invention. Accordingly, for the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,


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